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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,987	09/12/2003	Fumiya Ohmi	62301-Z CCD	6094

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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT PAPER NUMBER

2627

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<p><b>Application No.</b></p> <p>10/660,987</p>	<p><b>Applicant(s)</b></p> <p>OHMI, FUMIYA</p>	
	<p><b>Examiner</b></p> <p>Aristotelis M. Psitos</p>	<p><b>Art Unit</b></p> <p>2656</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

Applicant's response of 2/14/06 has been considered with the following results.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/589792, filed on June 8, 2000. ***Drawings***

The substitute drawing filed on 2/14/06 is greatly appreciated and has been entered.

However, the subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). As claimed, the process found in claim 9 is not depicted in any accompanying figures, and such should be submitted.

#### ***Specification***

The new title of the invention is greatly appreciated and has been entered. However, because the key feature is as found in the ultimate paragraph of claim 9, and such is not found in the new title, this new title is still not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure that is not enabling. The particular capability as found in the specification establishing the formatting power to be less than that previously established by the multiplication of a value less than 1 is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

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As argued in applicant's response, the required multiplication of the average calibrated power by a value less than 1, in order to yield the final desired result is not found in the claim. Hence the examiner concludes that this element is critical and needs to be positively recited.

Dependent claim 10 does not clarify the above problem and falls therewith.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention lacks patentable utility.

As understood from the disclosure, in formatting dis(c/k)s by different drives, an optimized laser power is established for each one. Nevertheless, if the established laser power is less than a universal lower limit, as required by the claim, nothing could be written to the dis(c/k). The examiner fails to understand why anyone would attempt to format a dis(c/k) at a power level less than that required to write to the dis(c/k). Such would lead to a dis(c/k) that had nothing overwritten, i.e., in effect nothing accomplished. If a user wanted a previously formatted dis(c/k) not to be formatted, there would be no need to perform any calibration procedure since there wouldn't be anything formatted. The examiner hence concludes that the claimed invention lacks any utility. Failing that, the claimed desired result(s) that of formatting a dis(c/k) would not be accomplished and hence doesn't achieve its' desired result.

***Response to Arguments***

Applicant's arguments filed 2/14/06 have been fully considered but they are not persuasive.

As recited in claim 9 ultimate paragraph:

".....formatting the medium at a recording power which is lower than the recording power determined as a result of the power calibration."

As understood by the examiner, the claim requires the ability to format a disc at a power level, which is less than, lower than, the recording power. This is not understood. If the laser power is indeed less than the required/calibrated recording power, how is anything every written/formatted to the disc, since the power level is LOWER than that required for formatting/writing?

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In addition, applicant's arguments as found on page 6 of their response – i.e., referring to the specification at page 5 are not persuasive, since again, the examiner cannot reconcile establishing a power level to be LESS than that required to format/write.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barton is cited as illustrative of prior art calibration procedures in this environment, in which the closest match to a pre-format level – see col. 2 lines 28-33 is disclosed.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-Thursday 8 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos  
Primary Examiner  
Art Unit 2656



AMP